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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,391	02/11/2004	Mitchell A. Altman	BIGTOE.003A	3924
20995	7590	01/10/2006		EXAMINER
		KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614		HOLLOWAY III, EDWIN C
			ART UNIT	PAPER NUMBER
				2635

DATE MAILED: 01/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/776,391	ALTMAN, MITCHELL A.
	Examiner	Art Unit
	Edwin C. Holloway, III	2635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 20 October 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-3 and 7-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-3 and 7-34 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

EXAMINER'S RESPONSE

1. In response to applicant's amendment filed 10-20-05, all the amendments to the specification and claims have been entered. The examiner has considered the new presentation of claims and applicant's arguments in view of the disclosure and the present state of the prior art. And it is the examiner's opinion that the claims are unpatentable for the reasons set forth in this Office action:

Claim Objections

2. Claims 1 and 20 are objected to because of the following informalities: The term "twenty" is misspelled in claim 1 lines 2 and 6 and in claim 20 line 5. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 16-17 and 30-31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to

reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The range of 1/10 to 1/4 second in claims 16 and 30 and the range on 1/10 to 1/2 second in claims 17 and 31 is not supported by the specification as originally filed. Paragraph 0005 of the original specification lists decreasing upper bounds of no more than 1/2 second, no more than 1/4 second and no more than 1/10 second that lack lower bounds and therefore does not correspond to the claimed ranges. Paragraph 0035 specifies a value of about 250 milliseconds (1/4 sec), but not the claimed range that includes a lower bound. The arguments with the 10-20-05 amendment argues that this time value between 20 encoded signals substantially increases the total time to send all the signals, but a description of substantially increasing the total time cannot be found in the original disclosure. A person annoyed with TV's would not want to substantially increase the total time to turn them off.

Claim Rejections - 35 USC § 102 & 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
6. Claims 1-2, 7-15, 20-21, 22-24 and 26-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Enomoto (US 5128667)

in combination with Fridley (US 6005486) and Emmons (US 5243430). Regarding claim 1, Enomoto discloses a universal remote control device 1 for effecting a function of a remotely controlled device including actuator (buttons or keys 2/3) to cause emitting of encoded signals from a database is disclosed in col. 3 lines 25-32 and col. 5 lines 42-56. The database of encoded signals for effecting control of a plurality of different device in the form of a lookup table in ROM 64 disclosed in col. 6 lines 45-53. An emitter 82 to emit the encoded signals is disclosed in col. 6 lines 54-68. Enomoto does not expressly disclose a housing, no more than 1/2 second between signals and twenty controlled devices. Emmons discloses a remote control for plural devices with a circular housing with buttons and multiple light emitting diodes for omnidirectional transmission of control signals, so the remote need not be pointed or have line of sight to the controlled device. See col. 1 line 49 - col. 2 line 7 and col. 2 lines 27-49. Fridley discloses transmitting a sequence or cluster of signals with 40 ms (less than 1/10 sec or 100 ms) delay between command in col. 19 lines 12-22. Regarding claim 1, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in Enomoto the housing Emmons to allow operation without accurate pointing or line of sight and it

Art Unit: 2635

further would have been obvious to have included the 40 ms delay of Fridley for rapid operation that is suggested by Enomoto disclosing only 0.6 ms between adjacent bits. Further regarding claims 1, although Enomoto shows 3 devices, the limitations of 20 devices would have been obvious in view of the reference to "several devices" in col. 6 line 9 of Enomoto, the remote controller of Enomoto is capable of controlling 20 different devices in range and the number 20 would have been obvious applicant's disclosure lacks criticality to the specific numbers claimed. Regarding claim 2, the function of Enomoto includes OFF in col. 5 line 48. Regarding claim 7, the controlled devices are television sets in col. 4 line 4 line 9 of Enomoto. Regarding claims 9-14, the circular housing of Emmons generally resembles a smiley face with a buttons 22a,b in the general area of the nose and multiple emitters 50 generally in the area of the eyes. Regarding claim 15, emitter 82 of Enomoto is an infrared LED in col. 6 lines 59-60.

Regarding claim 20, Enomoto discloses a method of effecting a function of a remotely controlled device including pointing a universal remote device 1 in the direction of (directed toward) the remotely controlled device in col. 3 lines 25-32 and col. 5 lines 42-56. The remote device includes a database of encoded signals for effecting control of a plurality of different device

in the form of a lookup table in ROM 64 disclosed in col. 6 lines 45-53. Actuating an actuator (operating/depressing keys 2/3) to cause emitting of the encoded signals from the database is disclosed in col. 3 lines 25-32 and col. 5 lines 42-56. Emitting the encoded signals by an emitter 82 is disclosed in col. 6 lines 54-68. Enomoto does not expressly disclose 20 controlled device, but this difference would have been for the same reasons applied above to claims 1. Regarding claim 22, emitter 82 is an infrared LED in col. 6 lines 59-60. Regarding claim 23, pointing at a second device and repeating the actuating and emitting steps is disclosed in col. 5 lines 57-66. Regarding claim 23, the function includes OFF in col. 5 line 48.

Regarding claim 21, Enomoto discloses transmitting the signal 3 times, but Fridley discloses transmitting a sequence or cluster of signals only once for eliminating a selection switch very rapid operation. See col. 9 line 48 - col. 10 line 9 and col. 12 lines 16-34. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in Enomoto the emission of the cluster only once as disclosed in Fridley for rapid operation. Regarding claim 26-28, repeating the operation to reverse the function between ON and OFF is disclosed in col. 12 lines 49-57 of Fridley and it would have been obvious to have included this operation in

Enomoto because the "ON or OFF" function in Enomoto suggests this toggle operation and col. 12 lines 49-57 of Fridley states that this is common in TV codes. Regarding claims 29, Fridley includes 40 ms (less than 1/10 sec or 100 ms) delay between command in col. 19 lines 12-22 of Fridley and would have been obvious in the combination for rapid operation and is suggested by Enomoto disclosing only 0.6 ms between adjacent bits in col. 4 lines 50-55.

7. Claims 3 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Enomoto (US 5128667) in combination with Fridley (US 6005486) and Emmons (US 5243430) as applied above and further in view of Vanderpohl (US 6366328). Regarding claim 3, Enomoto discloses volume decrement control in col. 3 line 68, but lacks mute control. Vanderpohl discloses a television remote control device and method that is a CIP of the Fridley Patent and includes a control signal clusters for plural devices with a mute function cluster. See the abstract and col. 13 lines 28-47. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the mute function cluster of Vanderpohl in the combination applied above to toggle between reduced and normal sound level, suggested by the volume decrement of Enomoto. Regarding claim 25, Enomoto discloses volume decrement control in col. 3 line 68, but lacks

mute control. Vanderpohl discloses a television remote control device and method that is a CIP of the Fridley Patent and includes a control signal clusters for plural devices with a mute function cluster. See the abstract and col. 13 lines 28-47. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the mute function cluster of Vanderpohl in the combination applied above to toggle between reduced and normal sound level, suggested by the volume decrement of Enomoto.

8. Claims 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Enomoto (US 5128667) in combination with Fridley (US 6005486) and Emmons (US 5243430) as applied above and further in view of Shim (US 6078270). Shim discloses a remote controller with a sequence of consecutive commands for controlling different device such as a TV and VCR in response to a single key press in col. 4 lines 5-43 for simplified operation. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the VCR control of Shim in the combination applied above for simplified operation that is suggested by Enomoto disclosing video devices in addition to televisions in col. 1 line 26 and col. 2 line 51.

9. Claims 18, 32 and 33 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Enomoto (US 5128667) in combination with Fridley (US 6005486) and Emmons (US 5243430) as applied above and further in view of Redford (US 5624265). Redford discloses simplified remote with a single button for single function for use by a child with single function of power toggle in the paragraph bridging cols. 1-2 that would have been obvious in the combination applied above to allow use by a child.

10. Claims 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Enomoto (US 5128667) in combination with Fridley (US 6005486) and Emmons (US 5243430) as applied above and further in view of Herweck (US 5731763). Herweck discloses a TV remote controller with a key chain housing in fig. 3A and col. 6 line 41 - col. 7 line 3 that would have been obvious in the combination applied above to allow small size.

Response to Arguments

11. Applicant's arguments filed 10-20-05 have been fully considered but they are not persuasive. The argument that "at least twenty devices" is a critical parameter is not persuasive to overcome the obviousness rejection because the specification as originally filed does not specify that the value of twenty is critical nor does it explain why this value is critical. To the contrary, paragraph 0004 list values of 5, 10 and 20. Original claims 4-6 also listed values of 5, 10 and 20 respectively.

Paragraph 0025 of the specification states that the number of power codes are maximized, but does not specify any particular or critical number of controlled devices. Further, the claims specifies a number of controlled devices, not a number of power codes. The claim does not specify that the "different" devices require different codes. Different models and different brands made by the same manufacturer or different manufacturers with licensing agreements may use the same codes. Therefore the transmitter of Enomoto would have been capable of controlling twenty different devices if 20 different devices each responsive to one of the codes stored in the transmitter are in range. A Sears or Sony store, for example, would include a display of many TV's with same or only a few different codes that would be within the capabilities of the Enomoto transmitter.

Applicant's continued reference to twenty different encoded signals in the arguments is not persuasive because the claims do not specify twenty different encoded signals. Further the argument that 19 time periods of 1/2 second in the with the 20 encoded signals would substantially increase the total time to transmit all the signals is not persuasive because substantially increasing the total transmitting time is not disclosed. To the contrary, the original claims and specification limit the time rather than increasing it.

The range of 1/10 to 1/4 second in claims 16 and 30 and the range on 1/10 to 1/2 second in claims 17 and 31 is not supported by the specification as originally filed. Paragraph 0005 of the original specification lists decreasing upper bounds of no more than 1/2 second, no more than 1/4 second and no more than 1/10 second that lack lower bounds and therefore does not correspond to the claimed ranges. Paragraph 0035 specifies a value of about 250 milliseconds (1/4 sec), but not the claimed range that includes a lower bound. Applicant argues that this time value between 20 encoded signals substantially increases the total time to send all the signals, but a description of substantially increasing the total time cannot be found in the original disclosure. A person annoyed with TV's would not want to substantially increase the total time to turn them off.

The argument regarding limiting the number of functions is not persuasive because Redford discloses a single button remote for use by a child with single function of power toggle in the paragraph bridging cols. 1-2.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Cook (US 5455570) discloses a remote control with 33 milliseconds between

repeated commands, but 250 milliseconds between different commands. See col. 13.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

CONTACT INFORMATION

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on

Art Unit: 2635

access to the Private PAIR system, contact an Electronic Business Center (EBC) representatives at 703-305-3028 or toll free at 866-217-9197 between the hours of 6 a.m. and midnight Monday through Friday EST, or by e-mail at ebc@uspto.gov. The Patent EBC is a complete customer service center that supports all Patent e-business products and service applications. Additional information is available on the Patent EBC Web site at <http://www.uspto.gov/ebc/index.html>.

Any inquiry of a general nature should be directed to the Technology Center 2600 receptionist at (571) 272-2600.

Facsimile submissions may be sent via central fax number 571-273-8300 to customer service for entry by technical support staff. Questions related to the operation of the facsimile system should be directed to the Electronic Business Center at (866) 217-9197. On July 15, 2005, the Central FAX Number will change to.

CENTRALIZED DELIVERY POLICY: For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314), and facsimile transmissions must be sent to the Central FAX number, unless an exception applies. For example, if the examiner has rejected claims in a regular U.S. patent application, and the reply to the examiner's Office action is desired to be transmitted by facsimile rather than mailed, the reply must be sent to the Central FAX Number. Inquiries concerning only hours and location of the Customer Window may be directed to OIPE Customer Service at (703) 308-1202.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edwin C. Holloway, III whose telephone number is (571) 272-3058. The examiner can normally be reached on M-F (8:30-5:00). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on (571) 272-3068.



EDWIN C. HOLLOWAY, III
PRIMARY EXAMINER
ART UNIT 2635

EH

1/9/06